

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 14, 2006 (the "Office Action"). At the time of the Office Action, Claims 1-21 were pending. The Office Action rejects Claims 1-3, 7-13 and 15-21 and objects to Claims 4-6 and 14. Applicants respectfully request reconsideration and favorable action in this case.

Section 101 Rejections

Claims 17-20 are rejected under 35 U.S.C. §101 because the Office Action contends that the claimed invention is directed to non-statutory matter. Applicants have amended independent Claim 17 to recite logic embodied as a computer program stored on a computer readable medium. Applicants respectfully request withdrawal of these rejections.

Section 103 Rejections

The Office Action rejects Claims 1, 2, 8, 9, 11, 12, 15, 17, 18, and 21 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,573,883 issued to Bartlett ("*Bartlett*") in view of U.S. Patent No. 6,564,144 issued to Cherveny ("*Cherveny*") and U.S. Patent No. 5,766,015 issued to Shpiro ("*Shpiro*"). The Office Action rejects Claims 3 and 7 under 35 U.S.C. 103(a) as being unpatentable over *Bartlett*, *Cherveny* and *Shpiro*, and further in view of U.S. Patent No. 6,791,536 issued to Keely ("*Keely*"). The Office Action rejects Claims 10, 16, and 20 under 35 U.S.C. 103(a) as being unpatentable over *Bartlett*, *Cherveny* and *Shpiro*, and further in view of U.S. Publication No. 2002/0190947 to Feinstein ("*Feinstein*"). Applicants respectfully traverse these rejections.

Claim 1 recites a control module operable to determine that a tracked movement does not indicate a unique one of the gestures and to generate feedback reporting that the tracked movement does not indicate a unique one of the gestures using the user interface. Claims 11, 17 and 21 recite similar elements. As the Office Action indicates, *Bartlett* does not disclose generating feedback reporting that the tracked movement does not indicate a unique one of the gestures. See Office Action, page 3. The Office Action also suggests that *Cherveny* teaches a data input device having a gesture recognition routine that outputs an audible output to a speaker indicating that a gesture has been recognized. See *id.* However, like *Bartlett*, *Cherveny* does not disclose generating feedback reporting that the tracked movement does not indicate a unique one of the gestures. The Office Action references *Shpiro* which

discloses an interactive language teaching system whereby a user speaks a phrase and the system notifies the user whether or not there is a match. *See* Office Action, page 3 and *Shpiro*, col. 5, lines 1-6. The Office Action states:

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bartlett to have the indicating features as taught by Cherveny and Shpiro to provide a feedback indication to the user clearly indicating to the user whether it indicates a gesture or not (col. 5, lines 3-6 of Shpiro).

Office Action, pages 3-4. However, no portion of any of the references discloses generating feedback reporting that tracked movement does not indicate a gesture. While *Shpiro* discloses an interactive language system that provides feedback to a user that an audio phrase spoken by the user does not match a particular audio phrase, this system does not relate in any way to a motion controlled handheld device and one that is able to detect motion of the device to operate as user input. While the Office Action cites to column 5, lines 3-6 of *Shpiro* (which discloses the feedback indication for the audio phrase) to support combining this reference with *Bartlett*, neither this nor any other portion provides the proper motivation strictly required by the M.P.E.P. and Federal Circuit caselaw to support such a combination.

According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). The "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432.

Therefore, at least because the references either alone or in combination do not disclose each claim element (e.g., generating feedback reporting that tracked movement does not indicate a unique gestures) and because there is no proper motivation to combine the references as suggested, Applicants respectfully submit that Claims 1, 11, 17 and 21 are patentable over the cited art used in the rejections and request that the rejections of these claims be withdrawn.

Claims 2-3 and 7-10 each depends from Claim 1, Claims 12-13 and 15-16 each depends from Claim 11 and Claims 18-20 each depends from Claim 17. Thus, for at least the reasons discussed above with respect to Claims 1, 11 and 17 Applicants respectfully request that the rejections of Claims 2-3, 7-10, 12-13, 15-16 and 18-20 be withdrawn.

Moreover, Claim 2 recites a control module operable to determine that a tracked movement indicates a plurality of probable ones of the gestures and operable to generate feedback using the user interface to report that the tracked movement indicates the probable gestures. Claims 12 and 18 recite similar elements. The Office Action does not cite to any portion of any reference that discloses determining that tracked movement indicates a plurality of probably ones of gestures or generating feedback to report that the tracked movement indicates the probably gestures, nor does any cited reference disclose these elements. Therefore, for at least these additional reasons, Applicants respectfully submit that Claims 2, 12 and 18 are patentable over the cited art used in the rejections and request that the rejections of these claims be withdrawn.

Allowable Subject Matter

Applicants note with appreciation that Claims 4-6 and 14 are indicated as having allowable subject matter. Applicants respectfully submit that Claims 4-6 and 14 are allowable as depending from allowable independent Claims 1 and 11.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees due or credit any overpayments, to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
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A handwritten signature in black ink, appearing to read "Chad C. Walters", with a stylized flourish at the end.

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